

REMARKS

Claims 37-72 were pending in the Application. Claims 37-72 were rejected under 35 U.S.C. §103(a). Claims 37-72 stand rejected under the judiciary created doctrine of non-statutory double patenting because the terminal disclaimer submitted with the previous response (mailed 11/01/2000) did not comply with 37 C.F.R. § 1.321 (b) and/or (c) since the terminal disclaimer was not dated. Applicants respectfully traverse the rejections and respectfully request that the Examiner reconsider and withdraw all outstanding rejections.

I. REJECTIONS UNDER 35 U.S.C. §103(a):

The Office Action has rejected claims 37-72 under 35 U.S.C. §103(a) as being unpatentable over Capps (U.S. Patent No. 5,66,502) in view of Dipaolo et al. (U.S. Patent No. 5,367,619) (hereinafter "Dipaolo"). The Office Action has further rejected claims 46, 58 and 70 under 35 U.S.C. §103(a) as being unpatentable over Luciw. Applicants respectfully traverse the rejections and respectfully request that the Examiner reconsider and withdraw all outstanding rejections.

A *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. See M.P.E.P. §2142. The motivation or suggestion to combine references must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The showings must be clear and particular. See *In re Dembicza*k, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not

evidence. *Id.* Furthermore, the references must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); M.P.E.P. § 2141.02.

In order to reject under 35 U.S.C. §103, therefore, the Examiner must provide a proper motivation for combining or modifying the references. See M.P.E.P. §2142; *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-1458 (Fed. Cir. 1998). The Examiner recites that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Dipaolo's teaching of automatic filling a data field to Capps for filling the data field with the most possible data entry from the list. Motivation of the combining is for the advantage of automatic filling of the data field without action by the user." See Office Action (dated August 2, 2000), Page 4.

There is no motivation to combine Capps with Dipaolo as there is no suggestion or motivation in Capps to ease the filling of data fields by *automatic filling* when fields have only *one valid data entry* and therefore one of ordinary skill would not be motivated to combine the references. Capps teaches that "the *historical list contains the most recently and/or frequently used data values* for the data field that the user is inputting data. Preferably, the *historical list is displayed over a form* also being displayed that requires the data input into its one or more of its fields. *By using the historical lists a user is able to enter data with a greater ease of use than previously obtainable.*" See abstract. Capps further teaches that "in any case, when the user seeks to enter data into the name field 184, the *user can click, tap or otherwise select the history list indicator 186 to obtain the history list for names*. Preferably, each history list is associated with a field class. The input fields of a form then designate the field class associated therewith." See Column 10, Lines 60-66. Dipaolo teaches that "fields which have only *one valid data entry* which is dependent upon entries made for designated other fields may be *designated automatically*." See Column 2, Lines 50-53. As interpreted by the Applicants, Dipaolo specifically limits automatic filling of fields to

those fields with only one defined data entry. That is, as interpreted by the Applicants, Dipaolo automatically enters the data of a specific data field *when there can only be one valid entry.* As stated above, *the references must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.* See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); M.P.E.P. § 2141.02. *Therefore, the automatic filling feature of Dipaolo may not be considered independently from the fact that the automatic filling feature is limited to filling those fields with only one defined data entry.* As interpreted by the Applicants, the purpose of having a *historical list in Capps* is to provide a list of a plurality of valid data entries the user may select. There is not just one valid entry. Therefore, there is *no motivation to combine Capps with Dipaolo as there would be no automatic filling because the fields have more than one valid entry.*

Furthermore, if the proposed modification or combination of the prior art would *change the principle of operation of the prior art invention being modified*, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Furthermore, if the proposed modification would *render the prior art invention being modified unsatisfactory for its intended purpose*, then there is no suggestion or motivation to make the proposed modification. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As stated above, Capps teaches that "the *historical list contains the most recently and/or frequently used data values* for the data field that the user is inputting data. Preferably, the *historical list is displayed over a form* also being displayed that requires the data input into its one or more of its fields. *By using the historical lists a user is able to enter data with a greater ease of use than previously obtainable.*" See abstract. Capps further teaches that "in any case, when the user seeks to enter data into the name field 184, the *user can click, tap or otherwise select the history list indicator 186 to obtain the history list for names.* Preferably, each history list is associated with a field class. The input fields of a form then designate the field class associated therewith." See Column 10, Lines 60-66. Dipaolo teaches that "fields which have only *one valid data entry* which

is dependent upon entries made for designated other fields may be *designated automatically.*" See Column 2, Lines 50-53. As stated above, *the references must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.* See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); M.P.E.P. § 2141.02. Therefore, the automatic filling feature of Dipaolo may not be considered independently from the fact that the automatic filling feature is limited to filling those fields with only one defined data entry. As interpreted by the Applicants, the *purpose or principle of operation* of Capps having a *historical list* is to provide a list of a plurality of valid data entries the user may select. By modifying Capps to automatically fill in those fields with only one defined data entry Capps would have no need to provide a historical list of possible valid data entries for the user to select. That is, the modification to Capps would *change the principle of operation in Capps* and subsequently render the operation of Capps to *perform its purpose unsatisfactory.*

Capps and Dipaolo, taken singly or in combination, do not teach or suggest "exercising a *predictive widget to supply a data entry* for a defined data field" as recited in claims 37, 49 and 61. Dipaolo teaches that "*fields which have only one valid data entry* which is dependent upon entries made for designated other fields *may be designated automatically.*" See Column 2, Lines 50-53. As interpreted by the Applicants, Dipaolo specifically limits automatic filling of fields to *those fields with only one defined data entry.* That is, as interpreted by the Applicants, Dipaolo automatically enters the data of a specific data field *when there can only be one valid entry.* When there can only be one valid entry in the data field, there is *nothing predictive* about what the entry of that specific data field should be.

Capps and Dipaolo, taken singly or in combination, do not teach or suggest "*exercising a predictive widget to supply one of a predictive default and a predictive fill selected from the predictive list as a data entry* for the defined data field" as recited in claims 48, 60 and 72. Capps teaches that "*the historical list contains the most recently and/or frequently used data values* for the

data field that the user is inputting data." See abstract. Dipaolo teaches that "*fields which have only one valid data entry* which is dependent upon entries made for designated other fields *may be designated automatically.*" See Column 2, Lines 50-53. As interpreted by the Applicants, Dipaolo specifically limits automatic filling of fields to *those fields with only one defined data entry*. That is, as interpreted by the Applicants, Dipaolo automatically enters the data of a specific data field *when there can only be one valid entry*. As interpreted by the Applicants, a control program implementing Dipaolo's automatic filling feature would not be able to *supply a predictive default and a predictive fill selected from the predictive list* as a data entry for the defined data field because the data field has more than one valid data entry with which the program selects from the predictive list. That is, the control program supplies an entry from the predictive list that *most likely* will be selected by the user but may not be the entry the user would have selected.

For at least the above reasons, claims 37, 48, 49, 60, 61 and 72 are patentable over Capps in view of Dipaolo and patentable over Luciw. Claims 38-47, 50-59 and 62-71 each recite combinations of features including the above combinations, and thus are patentable for at least the above reasons as well. Claims 38-47, 50-59 and 62-71 recite additional features which, in combination with the features of the claims upon which they depend, are patentable over Capps in view of Dipaolo and patentable over Luciw.

Capps and Dipaolo, taken singly or in combination, do not teach or suggest that "when the control program is executing on the processor, in storing a predictive list and *selecting a predictive default entry from the predictive list* based on a predetermined algorithm" as recited in claims 39, 51 and 63 and similarly in claims 40, 41, 42, 52, 53, 54, 64, 65 and 66. Capps teaches that "*the historical list contains the most recently and/or frequently used data values* for the data field that the user is inputting data." See abstract. Capps further teaches that "in any case, when the user seeks to enter data into the name field 184, the user can click, tap or otherwise *select the history list indicator 186 to obtain the history list for names*. Preferably, each history list is associated with a

field class. The input fields of a form then designate the field class associated therewith. See Column 10, Lines 60-66. Dipaolo teaches that "*fields which have only one valid data entry* which is dependent upon entries made for designated other fields *may be designated automatically.*" See Column 2, Lines 50-53. As interpreted by the Applicants, Dipaolo specifically limits automatic filling of fields to *those fields with only one defined data entry*. That is, as interpreted by the Applicants, Dipaolo automatically enters the data of a specific data field *when there can only be one valid entry*. As interpreted by the Applicants, a control program implementing Dipaolo's automatic filling feature would not be able to *select a predictive default entry from a predictive list* based on a predetermined algorithm because the data field has more than one valid data entry with which the program selects from the predictive list. That is, the control program selects an entry from the predictive list that *most likely* will be selected by the user but may not be the entry the user would have selected. Hence there is more than one valid entry.

Capps and Dipaolo, taken singly or in combination, do not teach or suggest that "when the computer program is executing on the processor, in *selecting a data entry from the predictive list based upon the recency of use of listed data entries*" as recited in claims 43, 55 and 67. Capps and Dipaolo, taken singly and in combination, do not teach or suggest that "when the computer program is executing on the processor, in *selecting a data entry from the predictive list based upon the frequency of use of listed data entries*" as recited in claims 44, 56 and 68. Capps and Dipaolo, taken singly and in combination, do not teach or suggest that "when the computer program is executing on the processor, in *selecting a data entry from the predictive list based upon a user selected weighted determination of the recency and frequency of use of listed data entries*" as recited in claims 45, 57 and 69. Capps teaches that "the history list 200 is the history list associated with the field class 'full name' and includes five (5) names of persons that were most recently and/or frequently used on the computer system." See Column 11, Lines 3-7. As interpreted by the Applicants, Capps simply teaches a history list with entries that were most recently and/or frequently used *but not a program selecting an entry from a predictive list based upon recency, frequency or*

a user selected weighted determination of the recency and frequency of use of the listed data entries. Dipaolo teaches that "fields which have only one valid data entry which is dependent upon entries made for designated other fields *may be designated automatically.*" See Column 2, Lines 50-53. As interpreted by the Applicants, Dipaolo specifically limits automatic filling of fields to *those fields with only one defined data entry.* That is, as interpreted by the Applicants, Dipaolo automatically enters the data of a specific data field *when there can only be one valid entry.* As interpreted by the Applicants, a control program implementing Dipaolo's automatic filling feature would not be able to *select a data entry from the predictive list based upon the recency or frequency of use or based upon a user selected weighted determination* because the data field has more than one valid data entry with which the program selects from the predictive list. That is, the control program selects an entry from the predictive list that *most likely* will be selected by the user but may not be the entry the user would have selected.

Capps, Dipaolo and Luciw, taken singly or in combination, do not teach or suggest that "storing the predictive list as a sequence of possible data entries and in ordering the sequence by positioning a *leading portion of the sequence based on the recency of use of listed data entries and a trailing portion of the sequence based on the frequency of use of listed data entries*" as recited in claims 46, 58 and 70. Capps teaches that "in this example, the name 'Diane Penn' was displayed before the name 'Steve Smith' because it was the *most recently used item* within the table 202 and the *relative difference in the frequencies of usage were not substantial enough to list them in the opposite order.*" See Column 11, Lines 47-51. Furthermore, Capps teaches that "lastly, the name 'Mary Kay' is placed in the history list 200 because within the history table 202, the name '*Mary Kay*' was *last in time* and its frequency is not substantially greater than other entries." See Column 11, Lines 58-61. As interpreted by the Applicants, the history list in Capps lists the order of names according to recency where the name in the top of the list is the most recent and the name on the bottom of the list is the least recent. Capps does not teach a *trailing portion of the sequence based on the frequency of use.* Furthermore, as interpreted by the Applicants, 'Steve Smith' would be

placed before 'Diane Penn' if the frequency of usage of 'Steve Smith' was substantially greater than the frequency of usage of 'Diane Penn.' Therefore, Capps does not teach a *leading portion of the sequence based on the recency of use of listed data entries*. The Office Action (dated August 2, 2000) states that Luciw fails to "clearly teach that the giving more weight to the recency of usage such that the list comprises a leading portion based on the recency of use and a trailing portion based on frequency of use." See Office Action (dated August 2, 2000), Page 8. The Office Action (dated August 2, 2000) further states that "giving more weight to the recency of usage would have been an obvious design preference." See Office Action (dated August 2, 2000), Page 8. Applicants respectfully contest the Office Action's assertion that it would have been obvious to give more weight to the recency of usage. *Applicants respectfully request a reference that supports the Office Action's assertion pursuant to M.P.E.P. §2144.03.* Furthermore, the Office Action (dated December 15, 2000) stated that "it is noted that the list is ordered based on a combination of recency and frequency, however, it would have been *obvious to one of skill in the art, at the time the invention was made, to separate the list into recency-of-use portion and frequency-of-use portion. Making a given structure separable would have been obvious to one skilled in the art* (Nerwin v. Erlichman, 168 USPQ 177, 179 (PTO Bd. Of Int. 1969))." See Office Action (dated December 15, 2000), Page 4. Applicants respectfully *contest that a historical list constitutes a structure.* Applicants respectfully contest the Examiner's assertion that it would have been obvious to separate the list into a recency-of-use portion and a frequency-of-use portion. *Applicants respectfully request a reference that supports the Office Action's assertion pursuant to M.P.E.P. §2144.03.*

As a result of the foregoing, Applicants respectfully assert that the Examiner's prima facie case of obviousness is not taught or suggested by the cited prior art since there are numerous claim limitations, and thus one skilled in the art would not have been able to create the claimed invention in view of the cited prior art.

II. NON-STATUTORY DOUBLE PATENTING REJECTIONS:

The Office Action has rejected claims 37-72 under the judiciary created doctrine of non-statutory double patenting as being unpatentable over Bertram et al. (U.S. Patent No. 5,864,340), Bertram et al. (U.S. Patent No. 5,805,159) and Bertram et al. (U.S. Patent No. 5,805,158).

While Applicants respectfully traverse this rejection as to at least some of the claims, to expedite prosecution of the present application, Applicants submit herewith a terminal disclaimer to overcome these rejections. Applicants note that filing of a terminal disclaimer is not an admission of the propriety of the non-statutory double patenting rejection. See M.P.E.P. § 804.02.

III. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that the remaining Claims in the Application are in condition for allowance, and respectfully request an early allowance of such Claims.

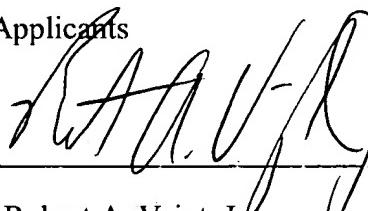
Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

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